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Precedent of the TTAB

Mailed: December 14, 2022

**UNITED STATES PATENT AND TRADEMARK OFFICE**

**Trademark Trial and Appeal Board**

*In re Media Minefield, Inc.*

Serial No. 88395484

Tye Biasco of Patterson Thuento Pedersen PA,  
for Media Minefield Inc.

Darryl M. Spruill, Trademark Examining Attorney, Law Office 112,  
Matthew J. Cuccias, Managing Attorney.

Before Cataldo, Lykos and Lynch,  
Administrative Trademark Judges.

Opinion by Cataldo, Administrative Trademark Judge:

Applicant, Media Minefield, Inc., filed an application amended to seek registration on the Supplemental Register of POSITIVE ONLINE PRESENCE as a mark in standard characters, identifying: “Providing marketing consulting in the field of social media,” in International Class 35.<sup>1</sup>

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<sup>1</sup> Application Serial No. 88395484 was filed on April 22, 2019, based on Applicant’s allegation of use of the mark anywhere and in commerce since April 15, 2019 under Section 1(a) of the Trademark Act, 15 U.S.C. § 1051(a).

The Trademark Examining Attorney refused registration of Applicant's proposed mark on the following grounds:

(1) under Trademark Act Sections 23(c) and 45, 15 U.S.C. §§1091(c), 1127, on the basis that the Applicant's mark is generic and thus incapable of distinguishing Applicant's services;

(2) under Trademark Act Sections 1, 2, 3, and 45, 15 U.S.C. §§1051-1053, 1127, on the basis that the applied-for mark is a slogan or term that does not function as a service mark to indicate the source of Applicant's services and to identify and distinguish them from others; and

(3) under Trademark Rules 2.32(a) and 2.71(a), 37 C.F.R. §§ 2.32(a) and 2.71(a), on the basis that Applicant's proposed amendment of its recitation of services to "providing marketing consulting in the field of social media, namely, providing and managing social media content for business executives," exceeds the scope of the original identification.

After the Trademark Examining Attorney made the refusals final, Applicant appealed to this Board. We affirm the refusals to register as discussed below.

I. Refusals of Registration on Grounds of Genericness and Failure to Function as a Mark

We first turn to the Examining Attorney's refusals of registration under Trademark Act Sections 23(c) and 45 on the ground of genericness and under

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Page references to the application record are to the downloadable .pdf version of the USPTO's Trademark Status & Document Retrieval (TSDR) system. References to the briefs, motions and orders on appeal are to the Board's TTABVUE docket system.

Trademark Act Sections 1, 2, 3 and 45 on the ground that POSITIVE ONLINE PRESENCE fails to function as a service mark. In his brief, the Examining Attorney outlines the procedural history of the refusals in the involved application. Relevant portions are reproduced below:

On April 22, 2019, applicant, Media Minefield, Inc. (hereinafter “applicant”), filed an application to register the standard character form mark POSITIVE ONLINE PRESENCE, under §1(a) of the Act, 15 U.S.C. §1051(a), on the Principal Register for Providing marketing consulting in the field of social media.

On July 11, 2019, examining attorney refused registration on the Principal Register (1) under Trademark Act Section 2(e)(1), 15 U.S.C. §1052(e)(1), because the applied-for mark merely describes feature, purpose, and/or nature of applicant’s services being provided; (2) under Trademark Act Sections 1, 2, 3, and 45, 15 U.S.C. §§1051-1053, 1127, because the applied-for mark is a slogan or term that is commonly used by those in applicant’s particular trade or industry to merely convey information about applicant’s or similar services; and (3) a Request for Information pursuant to 37 C.F.R. §2.61(b); TMEP §§814, 1402.01(e).

Applicant responded to the Office Action on January 13, 2020, arguing against the refusal on the basis that the proposed mark was not descriptive, and at most suggestive. Also, applicant satisfactorily responded to the Request for Information requirement.

On February 20, 2020, examining attorney issued a Final Office Action maintaining and continuing the refusals under Trademark Act Section 2(e)(1), 15 U.S.C. §1052(e)(1), and (2) under Trademark Act Sections 1, 2, 3, and 45, 15 U.S.C. §§1051-1053, 1127.

On August 20, 2020, applicant filed a Request for Reconsideration, and an amendment of the application to seek registration on the Supplemental Register. In response to the request, on September 21, 2020, examining attorney issued a new non-Final Office Action refusing registration of the mark under Trademark Act Sections 23(c) and 45, 15 U.S.C. §§1091(c), 1127, because the proposed mark appeared to be generic and thus incapable of distinguishing applicant’s services. Additionally, the refusal for registration was maintained and continued under Trademark Act Sections 1, 2, 3, and 45, 15 U.S.C. §§1051-1053, 1127.

Applicant responded to the Office Action on March 22, 2021, and in its response argued that the mark was capable on the Supplemental Register based on its proposed amendment to the identification of services, namely, “Providing marketing consulting in the field of social media, namely, providing and managing social media content for business executives.”

On April 23, 2021, examining attorney issued an Office Action maintaining and continuing the refusals under Trademark Act Sections 23(c) and 45, 15 U.S.C. §§1091(c), 1127, and Trademark Act Sections 1, 2, 3, and 45, 15 U.S.C. §§1051-1053, 1127. The Office Action also addressed the new issue regarding the proposed amendment to the identification of services.

The applicant on October 25, 2021, in its response argued that the proposed amendment was acceptable, and the amendment would result in the mark being eligible for registration on the Supplemental Register.

After careful consideration of applicant’s arguments, on February 4, 2022, examining attorney issued a Final Refusal for registration for the following reasons: (1) §2(e)(1) Descriptive Refusal,<sup>2</sup> (2) Informational Matter-Not Capable Refusal, (3) Refusal for Registration on the Supplemental Register, and (4) Identification of Services Unacceptable-Exceeds the Scope of Original Identification.

The applicant filed its Notice of Appeal on April 13, 2022, and Appeal Brief on June 13, 2022.<sup>3</sup>

Applicant’s outline of the procedural history of the involved application substantially agrees with that provided by the Examining Attorney.<sup>4</sup>

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<sup>2</sup> Neither Applicant nor the Examining Attorney argued this basis for refusal in their briefs. Applicant has conceded that its mark is at least merely descriptive of its identified services by seeking registration on the Supplemental Register. *See In re Rosemount Inc.*, 86 USPQ2d 1436, 1439 (TTAB 2008); *In re Eddie Z’s Blinds and Drapery, Inc.*, 74 USPQ2d 1037, 1039 (TTAB 2005). Applicant did not make its amendment to the Supplemental Register in the alternative, and the Examining Attorney did not treat it as such. *Contrast In re Binion*, 93 USPQ2d 1531, 1538 (TTAB 2009). We therefore disregard the mere descriptiveness ground for refusal of registration.

<sup>3</sup> Examining Attorney’s brief; 8 TTABVUE 3-5.

<sup>4</sup> Applicant’s brief; 6 TTABVUE 2-4.

The filing of a notice of appeal has the effect of appealing all refusals or requirements made final. *In re Citibank, N.A.*, 225 USPQ 612, 613 (TTAB 1985). Nonetheless, if an applicant, in its appeal brief, does not assert an argument made during prosecution, it may be deemed waived by the Board. *See In re Katch, LLC*, 2019 USPQ2d 233842, at \*1-2 (TTAB 2019) (applicant who briefed only the refusal under Section 23(c) waived its appeal of the refusal to registration under Trademark Sections 1, 2, 3 and 45); *In re Gibson Guitar Corp.*, 61 USPQ2d 1948, 1950 n.2 (TTAB 2001) (applicant did not, in its appeal brief, pursue claim of inherent distinctiveness, and therefore the claim was not considered by Board). *See also In re Rainier Enterprises, LLC*, 2019 USPQ2d 463361, \*2-3 (TTAB 2019) (failure to address refusals is a basis for dismissing the appeal); *In re Harley*, 119 USPQ2d 1755, 1758 (TTAB 2016) (failure to address any outstanding refusals is a basis for affirming the examining attorney's refusals on all grounds); *In re E5 LLC*, 103 USPQ2d 1578, 1579 n.1 (TTAB 2012) (during prosecution, applicant argued that mark was unitary but did not maintain argument in its appeal brief); TRADEMARK TRIAL AND APPEAL BOARD MANUAL OF PROCEDURE (TBMP) § 1203.02(g) (June 2022) and authorities cited therein.

An applicant's failure to address the refusals or requirements in its appeal brief is a basis for affirming an examining attorney's refusal of registration on those grounds. *See In re Rainier Enters., LLC*, 2019 USPQ2d 463361, at \*5 (TTAB 2019) (Board has discretion to "treat the failure as the equivalent of not filing a brief on that issue and dismiss the appeal, or to consider any challenge to that requirement

or refusal waived and affirm.”); *In re Harley*, 119 USPQ2d at 1757 (refusing registration based on failure to address or argue in its appeal brief any of the examining attorney’s refusals or requirements); *In re DTI P’ship, LLP*, 67 USPQ2d 1699, 1701-02 (TTAB 2003) (refusing registration based on failure to address request for information requirement, finding Section 2(e)(1) refusal moot); *In re Ridge Tahoe*, 221 USPQ 839, 840 (TTAB 1983) (failure to argue correctness of requirement may result in refusal on that ground alone); *In re Big Daddy’s Lounges Inc.*, 200 USPQ 371, 372 (TTAB 1978) (failure to respond or argue correctness of requirements on appeal could result in a decision refusing registration by default); *cf. Hyatt v. Dudas*, 551 F.3d 1307, 89 USPQ2d 1465, 1469 (Fed. Cir. 2008) (an appellant who fails to provide any argument in the appeal brief directed to rejected claims has waived a challenge to that ground of rejection, and the Board of Patent Appeals has the discretion to simply affirm any rejections against such claims).

In its brief, Applicant failed to address the Examining Attorney’s outstanding refusals of registration under Trademark Act Sections 23(c) and 45 on the ground of genericness and under Trademark Act Sections 1, 2, 3 and 45 on the ground that POSITIVE ONLINE PRESENCE fails to function as a service mark, or argue the merits thereof.<sup>5</sup> *See, e.g., In re Katch, LLC*, 2019 USPQ2d 233842, at \*1-2; *In re Harley*, 119 USPQ2d at 1757-58. In view thereof, Applicant has waived or forfeited any arguments on these grounds, and the refusals based on genericness and failure to function as a service mark are hereby affirmed.

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<sup>5</sup> Applicant did not submit a reply brief.

Applicant's failure to address the genericness and failure to function refusals is a sufficient basis, in itself, for affirming the refusal of registration of Applicant's mark, and deeming moot the rejection of Applicant's proposed amendment to its recitation of services. *In re DTI P'ship*, 67 USPQ2d at 1701-02. Nonetheless, for completeness, we exercise our discretion to determine below the merits of the proposed amendment to the identification of services.

## II. Proposed Amendment to Recitation of Services

In order to comply with statutory and regulatory requirements for filing an application, the wording of the identification must be clear and complete. 15 U.S.C. §§ 1051(a)(2) and 1051(b)(2); 37 C.F.R. § 2.32(a)(6). The USPTO has discretion to require the degree of particularity deemed necessary to identify with specificity the goods or services identified by the mark. *See In re Omega SA*, 494 F.3d 1362, 83 USPQ2d 1541, 1544 (Fed. Cir. 2007); *In re Fiat Grp. Mktg. & Corp. Commc'ns S.p.A.*, 109 USPQ2d 1593, 1597 (TTAB 2014).

Section 7(c) of the Trademark Act, 15 U.S.C. § 1057(c), provides that filing an application for registration on the Principal Register establishes constructive use and nationwide priority, contingent on issuance of the registration. Therefore, the identification of goods or services in an application defines the scope of those rights established by the filing of an application for registration on the Principal Register.

Trademark Rule 2.71(a), 37 C.F.R. § 2.71(a), provides as follows: "The applicant may amend the application to clarify or limit, but not to broaden, the identification of goods and/or services . . . ." 37 C.F.R. § 2.71(a); *see also In re Jimmy Moore LLC*, 119

USPQ2d 1764 (TTAB 2016). Thus, the scope of the original identification of goods or services establishes the limit for any subsequent amendments. *See* TRADEMARK MANUAL OF EXAMINING PROCEDURE (TMEP) § 1402.07 (July 2022) and authorities cited therein.

Applicant originally identified its services as follows: “Providing marketing consulting in the field of social media.” Applicant seeks to amend the services to “providing marketing consulting in the field of social media, namely, providing and managing social media content for business executives.” The Examining Attorney issued a final Office action refusing the amended identification of services as being beyond the scope as originally filed.

We take judicial notice of the relevant definitions of the following terms<sup>6</sup> in undertaking our analysis as to whether Applicant inappropriately broadened the original identification of services:

Marketing - the total of activities involved in the transfer of goods from the producer or seller to the consumer or buyer, including advertising, shipping, storing, and selling;<sup>7</sup>

Consulting - employed or involved in giving professional advice to the public or to those practicing the profession;<sup>8</sup> and

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<sup>6</sup> *See, e.g., In re White Jasmine LLC*, 106 USPQ2d 1385, 1392 n.23 (TTAB 2013) ((Board may take judicial notice of online dictionaries that exist in printed format or have regular fixed editions); *In re Red Bull GmbH*, 78 USPQ2d 1375, 1378 (TTAB 2006).

<sup>7</sup> Dictionary.com, definition retrieved from Random House Unabridged Dictionary (2022), accessed December 13, 2022.

<sup>8</sup> *Id.*

Managing - having administrative control or authority: *a managing director*.<sup>9</sup>

These definitions are probative in our determination that Applicant seeks to broaden its identification of services in violation of Trademark Rule 2.71(a). In particular, the amended identification adds the term “managing” which encompasses administrative control or authority exceeding the scope of “marketing consulting,” which consists of providing professional advice in the field of advertising, shipping, storing and selling goods by producers or sellers to consumers. We agree with Applicant that specifying its services are rendered to “business executives” limits the scope of the original identification. However, the addition of “managing” social media content expands the original inasmuch as having administrative control or authority – or managing – falls outside the scope of “marketing consulting.” Therefore, the proposed amendment is broadening, and the refusal is affirmed.

**Decision:** The refusals to register the mark in subject application Serial No. 88030290:

- (1) under Trademark Act Sections 23(c) and 45, 15 U.S.C. §§1091(c), 1127, on the ground of genericness;
- (2) under Trademark Act Sections 1, 2, 3, and 45, 15 U.S.C. §§1051-1053, 1127, on the ground of failure to function as a service mark; and

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<sup>9</sup> Dictionary.com, definition retrieved from Collins English Dictionary – Complete and Unabridged 2012 Digital Ed., accessed December 13, 2022.

(3) on the basis that Applicant's proposed amendment to the identification of Class 35 services exceeds the scope of the original services under 2.71(a), 37 C.F.R. §2.71(a),  
are affirmed.